

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1, 3-9, 14, and 15 are now pending in this application. Claims 7-9 and 14 have been withdrawn from consideration.

Rejections under 35 U.S.C. § 112

Claims 1, 3-6, and 15 are rejected under 35 U.S.C. § 112, first paragraph, as failing to meet the enablement requirement. Applicant respectfully submits that the amendments to the claims render this rejection moot. For instance, Applicant notes that claim 1 has been amended to recite a steel cord for reinforcing a synchronous belt consisting of, among other things, at least two and at most ten strands, each of said strands consisting of at least two and at most nineteen steel filaments. Applicant respectfully submits that the disclosure of Applicant's application provides support for the features of amended claim 1, such as, for example, on page 5, line 31, of Applicant's specification because a core surrounded by nine strands can provide 10 strands. Applicant respectfully submits that Applicant's specification enables one of ordinary skill in the art to make or use the steel cord of claim 1 without undue experimentation. Reconsideration and withdrawal of this rejection is respectfully requested.

Claims 1, 3-6, and 15 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. In regard to the rejections regarding the language "at least two strands twisted together...to form said strands" and "locally obtains," Applicant respectfully submits that the amendments to the claims render these rejections moot.

The Office argues on page 5 of the Office Action that claims 1, 3-6, and 15 are indefinite because they claim a steel cord in terms of its physical properties rather than its structural features. Applicant respectfully disagrees. Claim 1 clearly recites, among other things, a steel cord that includes at least two and at most ten strands twisted together, with each of the strands consisting of at least two and at most nineteen steel filaments, with the steel filaments having a diameter between 30 μm and 250 μm . These features regard structure, not physical properties. Thus, the steel cord of claims 1, 3-6, and 15 has not been solely claimed in terms of physical properties because the claims include structural features. Furthermore, the structural elongation of the steel cord recited in claim 1 is defined in claim 1 by a test that relates to a specific number of load cycles (20) and the breaking load of the steel cord. Applicant respectfully submits that one of ordinary skill in the art would be able to determine the scope of claim 1 and determine if a product was possibly within the scope of claim 1 or not.

For at least the reasons discussed above, reconsideration and withdrawal of these rejections is respectfully requested.

Rejection under 35 U.S.C. § 102

Claims 1, 3-6, and 15 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,206,907 to Marino *et al.* (hereafter “Marino”). This rejection is respectfully traversed.

A claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See generally MPEP § 2131.

Marino discloses an occlusion device with stranded wire support arms. See Marino at col. 3, lines 56-57. However, Marino discloses that a shape memory fixation device 14 includes the wire arms. See Marino at col. 3, lines 59-61, and col. 4, lines 3-5. Such shape memory devices utilize a martensitic phase transformation to provide the shape memory effect. Thus, Marino does not disclose a steel cord comprising, among other things, strands

made of filaments, said filaments being made out of plain carbon steel or austenitic stainless steel, said steels being substantially free of quenched martensitic structures, as recited in claim 1. Claims 3-6 and 15 depend from claim 1.

For at least the reasons discussed above, Marino does not anticipate claims 1, 3-6, and 15 because Marino does not disclose all of the features of claim 1. Reconsideration and withdrawal of this rejection is respectfully requested.

Rejections under 35 U.S.C. § 103

Claims 1, 3-6, and 15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,087,295 to Sargent *et al.* (hereafter “Sargent”). This rejection is respectfully traversed.

Sargent discloses a process for the mechanical and thermal treatment of steel wire to make a twisted strand or cord. See Sargent at col. 1, lines 6-10, and col. 2, lines 22-26. However, Sargent does not disclose or suggest a steel cord comprising, among other things, strands made of filaments, said filaments being made out of plain carbon steel or austenitic stainless steel, said steels being substantially free of quenched martensitic structures, as recited in claim 1, because Sargent discloses that the twisted strand or cord includes martensite. See Sargent at col. 1, lines 49-62.

For at least the reasons discussed above, Sargent does not render claims 1, 3-6, and 15 to be unpatentable because Sargent does not disclose or suggest all of the features of claim 1. Reconsideration and withdrawal of this rejection is respectfully requested.

Claims 1, 3-6, and 15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,509,710 to Redmond (hereafter “Redmond”). This rejection is respectfully traversed.

Redmond discloses a reinforced rubber article that includes strands made of individual wires. See Redmond at col. 1, lines 36-44. However, Redmond provides one example of two

strands that each consists of 188 steel wires and another example of two strands that each consists of 250 steel wires. See Redmond at col. 1, line 67, to col. 2, line 7. Thus, the strands disclosed by Redmond are not strands consisting of at least two and at most nineteen steel filaments, as recited in claim 1, because the strands of Redmond include more than nineteen wires.

Furthermore, Redmond discloses that the strands preferably have substantially zero twist, which is demonstrated by the fact that each strand is twisted about its own axis in the S direction the same amount that the strands are folded together in the Z direction to provide a cord. See Redmond at col. 1, lines 46, 66-72, and col. 2, lines 1-7. Such a process takes out the twists of the strands so they essentially are without twist, unlike the strands in the steel cord of claim 1.

For at least the reasons discussed above, Redmond does not render claims 1, 3-6, and 15 to be unpatentable because Redmond does not disclose or suggest all of the features of claim 1. Reconsideration and withdrawal of this rejection is respectfully requested.

Conclusion

Applicant submits that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing or a credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith,

Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date MAR 23 2009

By 

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 295-4011
Facsimile: (202) 672-5399

Glenn Law
Attorney for Applicant
Registration No. 34,371

Kevin McHenry
Attorney for Applicant
Registration No. 62,582